

REMARKS

In the Office Action dated March 1, 2004, the drawings were objected to; claims 1-3, 7-9, 18, 21, 40, 42, 43, and 46 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 4,450,912 (Callihan); claims 22-25, 28-31, and 44 were rejected under § 103 over Callihan in view of either U.S. Patent No. 5,718,287 (Streich) or U.S. Patent No. 3,638,730 (Smith); and claims 22-25 and 29-33 were rejected under § 103 over U.S. Patent No. 2,079,830 (Baker) in view of either Streich or Smith.

Applicant respectfully acknowledges the allowance of claims 4-6, 10-12, 15, 16, 27, 38, and 39, and the indication that claims 17, 19, 20, 41, 45, 47, and 48 would be allowable if objections were overcome.

Substitute drawings are submitted herewith to address the drawing objections. However, cross-hatching has not been added to Figs. 8, 9A, and 9B as such drawings are not sectional views. With the amended drawings, it is believed that the objections to the drawings have been overcome.

Claims 17, 20, 41, 45, and 47 have been amended from dependent form to independent form, with the scope of each of these claims remaining unchanged. These claims are in condition for allowance.

Claims 1, 22, and 42 have been cancelled, without prejudice to filing such claims in a continuation application.

Claim 29 has been amended from dependent form to independent form, with the scope of the claim remaining unchanged. Claim 29 was rejected as being obvious over (1) Callihan in view of Streich or Smith, or (2) Baker in view of Streich or Smith.

Applicant respectfully submits that the asserted combination of Callihan and Streich or Smith does not render claim 29 obvious. Claim 29 recites a method of cementing a casing assembly *at a junction of plural wellbores*, which includes lifting the cementing tool from the casing assembly after disengagement of the cementing tool from the casing assembly, which can be accomplished *without first milling the junction of plural wellbores*. Callihan describes a single wellbore system. Therefore, the method as recited in claim 29 relating to cementing a casing assembly at a junction of plural wellbore and lifting a cementing tool without first milling at the junction of plural

wellbores is not taught or suggested by Callihan. Streich and Smith also does not provide any teaching of cementing a casing assembly at a junction of plural wellbores. Therefore, even if Callihan and Streich or Smith can be properly combined, the hypothetical combination of such references does not teach or suggest *all* elements of claim 29.

Moreover, there is no motivation or suggestion to combine Callihan and Streich or Smith in the manner proposed by the Office Action. As explicitly taught by Callihan, the cementing stage apparatus disposed within a casing extension 2 "may be drilled out in order to provide a larger bore for the insertion of production equipment." Callihan, 7:59-66. Such a teaching of Callihan directly contradicts the subject matter of claim 29, where lifting of a cementing tool is accomplished *without first milling at the junction*. Because Callihan teaches away from the claimed invention, there is no motivation or suggestion to combine Callihan and Streich or Smith. In view of the foregoing, a *prima facie* case of obviousness has not been established with respect to claim 29 over Callihan in view of Streich or Smith.

Similarly, claim 29 is also allowable over the asserted combination of Baker and Streich or Smith. Baker also does not disclose a method of cementing a casing assembly at a junction of plural wellbores that includes lifting the cementing tool without first milling at the *junction of the plural wellbores*. Thus, even if Baker and Streich or Smith can be properly combined, the asserted combination of references does not teach or suggest *all* the elements of claim 29. The *prima facie* case of obviousness against claim 29 fails for at least this reason.


Also, there is no motivation or suggestion to combine the teachings of Baker with Streich or Smith. Baker employs the use of a valve 28 (which is basically a spring-loaded check valve) to control the flow of cement through the valve port 27 (*see* Figure 1 of Baker). Baker provides no suggestion to employ the use of a plug that has a rupture element in the system of Baker. There is no suggestion found anywhere in Baker and Smith or Streich (whether explicit or implicit) of any need to replace the valve 28 with a plug having a rupture element as recited in claim 29.

Furthermore, the Office Action provided a one-sentence discussion with respect to the rejection of the claims over the asserted combination of Baker and Streich or Smith. The discussion of this obviousness rejection is as follows: "The Streich et al and

Smith references are applied as above." The Office Action has failed to provide any explanation regarding what support exists to combine the reference teachings. To establish a *prima facie* case of obviousness, three basic criteria must be met. There must be some suggestion or motivation to combine reference teachings. There must be a reasonable expectation of success. The prior art references when combined must teach or suggest all claim limitations. See MPEP § 2143 (8th ed., Rev. 1) at 2100-124. As stated by the MPEP, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. *Id.* The Examiner has not provided any reasoning with respect to how Baker and Streich or Smith can be combined. Therefore, the requirements of establishing a *prima facie* case of obviousness has not been satisfied.

In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0190US).

Respectfully submitted,



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